

REMARKS

Applicant has reviewed and considered the Final Office Action of April 19, 2004, and the references cited therewith.

No claims were amended, canceled, or added. Claims 1-5, 9-10, and 13-18 are still pending in this application.

§102 Rejection of the Claims

Claims 1-4, 9, 10, 13, 16, and 18 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,473,072 to Comiskey, et al. (hereinafter "Comiskey"). Applicant respectfully traverses the rejections as follows.

Applicant does not admit that Comiskey is indeed prior art and reserves the right to swear behind the reference at a later date. Nonetheless, Applicant believes the presented claims are distinguishable from Comiskey for at least the following reasons.

Claim 1

Applicant's independent claim 1 recites a whiteboard apparatus that includes, besides other things,

a user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device, the reference images comprising a predefined image which is used to assist the user in drawing a related image over the reference with out having to first draw the reference image.

The Examiner cited Comiskey to at least illustrate a display device. Applicant respectfully submits, however, Comiskey fails to teach all the elements recited in claim 1. For example, the Examiner asserts that Comiskey "teaches of user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image (col. 14, lines 47-53 and col. 16, lines 48-68)." The Examiner further asserts that "the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6)."

From Applicant's review, the above cited portions of Comiskey fail to support the Examiner's assertions. For example, Comiskey fails to teach a user interface device that enables a user to select one of a plurality of reference images to be displayed on the electronic paper display device, as recited in claim 1. In contrast, Comiskey appears to describe a drawing system that "[t]he system 125 further includes an electrostatic printer 123 for providing an underlying image on the drawing surface 129" (col. 14, lines 47-49). In addition, Comiskey provides in an altogether different embodiment for a

display 160 [that] includes an electrostatic printing mechanism . . . included in a sliding bar 162 . . . [that] can be used as a manual or automatic electrostatic print head and can transfer images to the drawing screen when the user slides the sliding bar 162 . . . [t]he display 160 of FIG. 15b allows a user to download and display an image on the drawing screen . . . [where] [t]he image can be . . . an interactive series of image" (col. 16, lines 44-64).

Comiskey, however, fails to teach that either the "system 125" or the "display 160" includes a user interface device that enables a user to select one of a plurality of reference images to be displayed on the electronic paper display device, as recited in claim 1. In other words, "an interactive series of image" does not teach a user interface device that enables a user to select one of a plurality of reference images to be displayed on the electronic paper display device, as recited in claim 1. Put another way, Comiskey fails to teach that a selection is made from these interactive series of images.

Applicant further traverses the Examiner assertion that "the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6)." This cited portion of Comiskey provides that "the sliding bar 162 supports a scanning device [that] . . . can digitize the image provided on the screen of the drawing system [where] . . . the drawing system [can] . . . store, recall and transmit images" (col. 17, lines 1-6). Applicant respectfully submits that this fails to teach a user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device, as recited in claim 1. Rather, Comiskey indicates that the "drawing system" can "store, recall and transmit images," but not that a user interface is used to allow a user to select one of a plurality of reference images. In addition, nothing in Comiskey suggests that it

would have been inherent to select one of a plurality of reference images. As such, Applicant submits that Comiskey does not teach all the elements recited in claim 1.

In addition, Comiskey fails to teach that, in contrast to the "system 125" embodiment, the "display 160" having the "interactive series of image" includes a "drawing surface 129" as discussed above. In other words, it appears that elements of two distinct embodiments (*i.e.*, picking and choosing unrelated elements) of Comiskey are being combined in making the anticipatory rejection of claim 1. In addition, there is no motivation to combine these different embodiments of Comiskey, as doing so would defeat the purpose of each of the separate embodiments.

In order to anticipate a claim, the reference must teach every element of the claim. MPEP § 2131. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is impermissible to assemble what is claimed by putting together unconnected elements from the reference.

Based on the forgoing, Applicant respectfully submits that each and every element of independent claim 1 is not taught in Comiskey. Therefore, the 102 rejection should be withdrawn.

Reconsideration and withdrawal of the 102 rejection for the above independent claim, as well as those claims which depend therefrom, are respectfully requested.

Claim 10

Applicant's independent claim 10 recites a method that includes;
enabling a user to select one of a plurality of reference images to be displayed on an electronic paper display device, the reference images comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image.

Applicant respectfully submits Comiskey fails to teach all the elements recited in claim 10. For example, the Examiner asserts that Comiskey "teaches of a method comprising the steps of . . . enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the

reference image without having to first draw the reference image (col. 14, lines 47-53 and col. 16, lines 48-68)." The Examiner further asserts that "the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6)."

From Applicant's review, the above cited portions of Comiskey fail to support the Examiner's assertions. For example, Comiskey fails to teach enabling a user to select one of a plurality of reference images to be displayed on an electronic paper display device, as recited in claim 10. Applicant respectfully repeats the discussion above for claim 1 in support of these submissions.

Applicant further traverses the Examiner assertion that "the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6)." Applicant respectfully repeats the discussion above for claim 1 in support of these submissions.

In addition, Comiskey fails to teach that, in contrast to the "system 125" embodiment, the "display 160" having the "interactive series of image" includes a "drawing surface 129" as discussed above. In other words, it appears that elements of two distinct embodiments (*i.e.*, picking and choosing unrelated elements) of Comiskey are being combined in making the anticipatory rejection of claim 10. There is no motivation to combine these different embodiments of Comiskey, as doing so would defeat the purpose of each of the separate embodiments.

Based on the forgoing, Applicant respectfully submits each and every element of independent claim 10 is not taught in Comiskey. Therefore, the 102 rejection should be withdrawn.

Reconsideration and withdrawal of the 102 rejection for the above independent claim, as well as those claims which depend therefrom, are respectfully requested.

§103 Rejection of the Claims

Claims 5, 14, and 15 were rejected under 35 USC § 103(a) as being unpatentable over Comiskey in view of U.S. Patent No. 6,177,927 to Chery, et al. (hereinafter "Chery"). Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Comiskey in view of applicant's admitted prior art (APA). Applicant respectfully traverses the rejections as follows.

The Examiner cited Comiskey to at least illustrate a display device. As discussed above, Comiskey provides a display device, but fails to teach or suggest a user interface to enable a user to select one of a plurality of reference images to be displayed on the electronic paper display device, as recited in claims 1 and 10.

The Examiner cited Chery to at least illustrate a "reference image comprising a Cartesian plane, or a template of a flowchart." Chery, however, does not cure the above identified deficiencies of Comiskey. That is, Chery does not address, suggest or teach enabling a user to select one of a plurality of reference images. As such, each and every element of independent claims 1 and 10 is not taught or suggested in Comiskey and Chery, either independently or in combination. As claim 5 is a dependent claim of independent claim 1, and claims 14 and 15 are dependent claims of independent claim 10, the 103 rejection of claims 5, 14, and 15 should be withdrawn.

With respect to claim 17, claim 17 depends from allowable claim 10. That is, for the reasons presented above, Applicant respectfully submits that as each and every element of independent claim 10 is not taught or suggested in Comiskey or the combination of reference. Therefore the 103 rejection of dependent claim 17 should be withdrawn.

Reconsideration and withdrawal of the 103 rejections for the above dependent claims are respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (360) 212-8052.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450 Alexandria, VA 22313-1450, on this 15th day of June, 2004.

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